



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,886	10/13/2000	Kail Lester Linebrink	13DV13462	8821

29399 7590 07/29/2004
JOHN S. BEULICK
C/O ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102-2740

EXAMINER

KOCZO JR, MICHAEL

ART UNIT PAPER NUMBER

3746

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,886

Applicant(s)

LINEBRINK, KAIL LESTER

Examiner

Michael Koczko, Jr.

Art Unit

3746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9, 11-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3746

DETAILED ACTION

Applicant's arguments filed on May 25, 2004 have been fully considered but they are not persuasive.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structure of claim 1 (fuel system interface receiving electrically and mechanically originated over-speed signals) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Applicant argues that the structure of claim 1 is shown in figures 2 and 4. However, figures 2 and 4 show separate embodiments. No figure shows a fuel system interface which receives electrically **and** mechanically originated over-speed signals.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The amendment filed on July 28, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendments to page 2, paragraph 2.

Art Unit: 3746

Applicant argues that the claims as filed in the original specification are part of the disclosure and applicant may amend the specification to include the claimed subject matter. This would apply if there were no conflict between the claimed subject matter and the subject matter described in the specification. However, in the instant application as originally filed, the claimed subject matter (version I: electrically and mechanically originated over-speed signals) conflicts with that which is described in the specification (version II: electrically or mechanically-originated over-speed signals). In order to determine which of these versions applicant intended to be the invention, one must establish which version has the most descriptive support. The only support for version I is in the claims. The drawings support only version II since they show the electrically or mechanically originated over-speed signals as separate embodiments in separate figures. The specification also supports only version II. See page 2, line 4 (“electrically-originated or [emphasis added] mechanically-originated over-speed sensing system”), page 2, line 20, (“fuel flow can only be initiated when the [emphasis added] overspeed signal is removed”), and page 7, lines 19 and 20 (“The interface accomodates overspeed signals that originated from electronic or [emphasis added] mechanical speed sensors.”). This evidence indicates that applicant intended version II as his invention. Therefore, applicant cannot now attempt to rewrite the specification to conform with the claims without introducing new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

Claims 1, 2, 3 and 5 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

Art Unit: 3746

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites a fuel system interface receiving electrically and mechanically originated over-speed signals. There is no detailed description, or any mention whatsoever, in the specification, as originally filed, of a fuel system interface which receives electrically and mechanically originated over-speed signals. The original specification describes a fuel system interface which receives only electrically originated over-speed signals (figure 2), a fuel system interface which receives only mechanically originated over-speed signals (figure 4) and a fuel system interface which receives only hydraulically originated over-speed signals (figure 5).

One of ordinary skill in the art would therefore not know what is the purpose of having electrically and mechanically originated over-speed signals, and how the electrical and mechanical speed sensors would operate in conjunction with each other and how they would interface with the fuel control system. This would require undue experimentation by one of ordinary skill in the art to render the invention as enabling.

Claims 6 to 9, 11 to 16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite that the fuel system interface receives a plurality of overspeed signals and that "fuel flow is only initiated when each over-speed signal is removed" (emphasis added). This is new matter because there is no basis for this in the specification as originally filed. For

Art Unit: 3746

example, see page 6, line 15, which states that “fuel flow can only be initiated when the over-speed signal is removed” (emphasis added). That is, there is only one overspeed signal, not a plurality as claimed.

Applicant's arguments are merely unsubstantiated allegations. For example, applicant argues that “one of ordinary skill in the art, after reading the specification in view of the Figures, would determine that the subject matter in the specification is described in such a manner as to reasonably convey that the Applicant had possession of the claimed invention, at the time the application was filed.” However, no evidence, such as affidavits, has been submitted to support these allegations.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6 to 9, 11 to 16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 13 recite that “fuel flow is only initiated when each over-speed signal is removed” (emphasis added). It is not understood what is the meaning of “each” in the context of the claims. These claims merely recite a single source for the over-speed signals.

Conclusion

The prior art could not be applied to the claims due to their basis on an non-enabling disclosure.

Art Unit: 3746

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry relating to the status of this application or proceeding should be directed to the Customer Service Office whose telephone number is 703-306-5648.

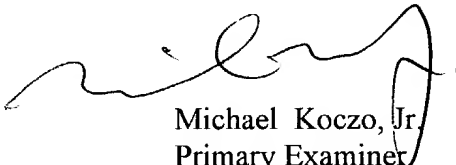
Any inquiry relating to patent applications in general should be directed to the Patent Assistance Center at 1-800-786-9199.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Koczo, Jr. whose telephone number is 703-308-2630. The examiner can normally be reached on M-F; 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 703-308-2675. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3746

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Koczo, Jr.
Primary Examiner
Art Unit 3746